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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,428	03/01/2000	Kevin D. Satterfield	ODS-10	3649
1473	7590	08/02/2007	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			HAYES, JOHN W	
		ART UNIT	PAPER NUMBER	
		3628		
		MAIL DATE		DELIVERY MODE
		08/02/2007		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/516,428	SATTERFIELD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John W. Hayes	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 March 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-61 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 15, 2004 has been entered.

### ***Response to Arguments***

- 2) The applicant's amendment filed on March 15, 2004 has been entered.
- 3) Applicant's arguments, filed March 15, 2004, with respect to the rejections of the Claims under 35 U.S.C. section 102 and 103 have been fully considered and are persuasive. The previous rejection of the claims 1-61 has been withdrawn.
- 4) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 101***

- 5) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 6) Claims 34-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 34, the preamble recites “a machine readable medium for use in an interactive wagering system, the machine readable medium comprising machine readable instructions recorded thereon..”, however, does not recite a computer readable medium embodied with a computer program, that when executed by a computer, carries out the claimed steps. A machine readable medium is not necessarily a computer readable medium and, therefore, the claim is directed to functionally descriptive material that is not functionally or structurally interrelated to the medium. Data structures not claimed as embodied in computer readable media are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. Such claimed data structures do no define any structural and functional interrelationships between the data structure. See MPEP 2106.01(I).

Claims 35-61 depend from claim 34 and are rejected for the same reasons.

#### ***Claim Rejections - 35 USC § 112***

7) Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 32 is written in “single means claim” format since they recite only one element to do all the functions recited. The claim is not written in “means-plus-function” language, however, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC

affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use “means-plus-function” language. Claim 32 is drawn to any “User television equipment”, regardless of construct, that performs the function recited. This parallels the fact situation in *Fiers* wherein “a DNA” and a result was recited. The CAFC stated in *Fiers* at 1606 “Claiming all DNA’s that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived”. See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous to single means claims even though “means” was not literally used. Thus, claim 32 yields a “user television equipment” that achieves a result without defining what will do so.

***Claim Rejections - 35 USC § 102***

8) Claims 1-3, 14-18, 20, 26-27, 34-36, 47-51, 53, and 59-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Graves et al. (US 5,830,067).

As for Claim 1:

Graves et al. disclose a method for interactive wagering on races comprising:  
allowing a user to access to access an interactive wagering service to select desired wagering criteria (col. 4, lines 17-42; col. 4, line 55 – col. 5, line 21; col. 6, line 58 - col. 7, line 4; see Fig. 1);  
using the interactive wagering application to determine whether a desired wagering opportunity exists; and

using the interactive wagering application to automatically take a particular action (automatically placing a wager) whenever the wagering criteria are satisfied (see Supra and Figs. 1-4).

- As for Claim 2: Graves et al. further discloses the method including using the application to provide the user with an opportunity to select which particular action is taken whenever the wagering criteria are satisfied (Id.);

- As for Claim 3: Graves et al. further discloses the method including using user television equipment, using the application on the user television equipment to determine whether the wagering criteria are satisfied (see Col. 1, lines 27-33);

- As for Claim 14: Graves et al. further discloses the method including providing the user with an opportunity to select whether the action taken involves the automatic placing of a wager (col. 4, lines 17-42; col. 4, line 55 – col. 5, line 21; col. 6, line 58 – col. 7, line 4);

- As for Claim 15: Graves et al. further discloses the method wherein the action taken involves the automatic placing of a wager, the method further including providing the user with an opportunity to select a wager amount and amount type (Id.);

- As for Claim 16: Graves et al. further discloses the method wherein there are multiple sets of wagering criteria established by the user, each with an associated action to be taken (col. 2, lines 39-43, playing multiple games), the method further including providing the user with an opportunity to select a different wager amount and wager type for each of the multiple sets of wagering criteria (col. 2, line 63 – col. 3, line 7);

- As for Claim 17: Graves et al. further discloses the method including providing different user interfaces with the wagering application for selecting different types of wagering criteria (Id.);

- As for Claim 18: Graves et al. further discloses the method including providing the user with an opportunity to select whether the action taken involves notification of the user (see Supra columns);

- As for Claim 20: Graves et al. further discloses the method including notifying the user that the wagering criteria have been satisfied using an e-mail (col. 6, lines 22-41);

- As for Claim 26: Graves et al. further discloses the method including using the wagering application to limit automatic wagering based on monetary wagering limits (see Fig. 3 and the description thereof);

- As for Claim 27: Graves et al. further discloses the method including providing the user with an opportunity to select a desired monetary wagering limit; and using the wagering application to limit automatic wagering based on the monetary wagering limit (Id.);

As for Claim 34:

Graves et al. disclose a machine-readable medium comprising instructions for: allowing a user to select desired wagering criteria (col. 4, lines 17-42; col. 4, line 55 – col. 5, line 21; col. 6, line 58 – col. 7, line 4; see Fig. 1); determining whether a desired wagering opportunity exists; and automatically taking a particular action (automatically placing a wager) whenever the wagering criteria are satisfied (see Supra and Figs. 1-4).

- As for Claim 35: Graves et al. further discloses the medium including using the application to provide the user with an opportunity to select which particular action is taken whenever the wagering criteria are satisfied (Id.);

- As for Claim 36: Graves et al. further discloses the medium wherein the medium is used with user television equipment (see Supra);

- As for Claim 47: Graves et al. further discloses the medium including providing the user with an opportunity to select whether the action taken involves the automatic

placing of a wager (col. 4, lines 17-42; col. 4, line 55 – col. 5, line 21; col. 6, line 58 – col. 7, line 4);

- As for Claim 48: Graves et al. further discloses the medium, wherein the action taken involves the automatic placing of a wager, the medium further including providing the user with an opportunity to select a wager amount and amount type (Id.);

- As for Claim 49: Graves et al. further discloses the medium wherein there are multiple sets of wagering criteria established by the user, each with an associated action to be taken (col. 2, lines 39-43, playing multiple games), the medium further including providing the user with an opportunity to select a different wager amount and wager type for each of the multiple sets of wagering criteria (col. 2, line 63 – col. 3, line 7);

- As for Claim 50: Graves et al. further discloses the medium including providing different user interfaces with the wagering application for selecting different types of wagering criteria (Id.);

- As for Claim 51: Graves et al. further discloses the medium including providing the user with an opportunity to select whether the action taken involves notification of the user (see Supra columns);

- As for Claim 53: Graves et al. further discloses the medium including notifying the user that the wagering criteria have been satisfied using an e-mail (col. 6, lines 22-41);

- As for Claim 59: Graves et al. further discloses the medium including using the wagering application to limit automatic wagering based on monetary wagering limits (see Fig. 3 and the description thereof); and

- As for Claim 60: Graves et al. further discloses the medium including providing the user with an opportunity to select a desired monetary wagering limit; and using the wagering application to limit automatic wagering based on the monetary wagering limit (Id.).

#### ***Claim Rejections - 35 USC § 103***

9) Claims 4-13, 19, 21-25, 29-33, 37-46, 52 and 54-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graves et al. as applied to claims 1 and 34 above, and further in view of Brenner et al. (US 6,099,409).

As for Claims 4-13, 37-46:

Graves et al. discloses the invention as recited earlier but does not expressly disclose the invention including:

providing the user with an opportunity to select a particular racetrack – Claims 4 and 37; to select a particular horse – Claims 5 and 38; to search for a desired horse

with a remote control – Claims 6 and 39; to select a particular jockey – Claims 7 and 40; to select a particular trainer – Claims 8 and 41; to select a particular track surface – Claims 9 and 42; to select a particular race distance – Claims 10 and 43; to select a particular racing statistics – Claims 11 and 44; to select a particular silk color – Claims 12 and 45; and to wager by odds for a horse change from that horse's morning line odds – Claims 13 and 46.

Brenner et al. teaches, for a interactive wagering system for horse racing games, that the system allows the user to select a particular racetrack, a particular horse; to search for a desired horse with a remote control; to select a particular jockey, a particular trainer, a particular track surface, a particular race distance, a particular racing statistics, and a particular silk color; and to wager by odds for a horse change from that horse's morning line odds (see Figs. 3, , 5, 8-28, 36-50 and the descriptions thereof).

Since Brenner et al. and Graves et al. are both from the same filed of endeavor, the purpose disclosed by Brenner et al. would have been well recognized in the pertinent field of Graves et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the system of Graves et al. to play the horse racetrack wagering (to select a particular racetrack, a particular...), as taught by Brenner et al., for the purpose of providing the user with the interactive wagering systems and related processes for off-track horse racing wagering in which a user terminal provides racing odds, pools, handicapping information, and other racing data.

As for Claims 19, 21-25:

The modified method of Graves et al. further discloses the invention including:

notifying the user by displaying a partial-screen overlay message on top of a screen (col. 2, lines 43-46 of Brenner et al.) – Claim 19;

notifying the user via a wireless message (col. 7, lines 35-38 of Brenner et al.) –

Claim 21;

notifying the user that the wagering criteria have been satisfied by displaying a message on the TV (col. 1, lines 13-15 of Brenner et al.) – Claim 22;

providing a display screen containing a summary of which types of wagering criteria have been established (col. 3, lines 15-18 of Brenner et al.) – Claim 23;

wherein the summary includes information on wager amounts and wager types that the user has established for use whenever various sets of wagering criteria are satisfied (col. 2, lines 47-53 of Brenner et al.) – Claim 24; and

wherein the summary includes information on wager amounts and wager types that the user has established for use whenever various sets of wagering criteria are satisfied (col. 2, lines 47-53 of Brenner et al.) – Claim 25.

As for Claim 29:

Graves et al. discloses a method for interactive wagering comprising:

allowing a user to select desired wagering criteria (col. 4, lines 17-42; col. 4, line 55 – col. 5, line 21; col. 6, line 58 - col. 7, line 4; see Fig. 1);

determining whether a desired wagering opportunity exists; and automatically taking a particular action (automatically placing a wager) whenever the wagering criteria are satisfied (see Supra and Figs. 1-4).

However, Graves et al. does not expressly disclose the invention that allows the user to select a given horse.

Brenner et al. teaches, for a interactive wagering system for horse racing games, that the system allows the user to select a particular racetrack, a particular horse; to search for a desired horse with a remote control; to select a particular jockey, a particular trainer, a particular track surface, a particular race distance, a particular racing statistics, and a particular silk color; and to wager by odds for a horse change from that horse's morning line odds (see Figs. 3, , 5, 8-28, 36-50 and the descriptions thereof).

Since Brenner et al. and Graves et al. are both from the same field of endeavor, the purpose disclosed by Brenner et al. would have been well recognized in the pertinent field of Graves et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the system of Graves et al. to play the horse racetrack wagering (to select a particular racetrack, a particular...), as taught by Brenner et al., for the purpose of providing the user with the interactive wagering

systems and related processes for off-track horse racing wagering in which a user terminal provides racing odds, pools, handicapping information, and other racing data.

- As for Claim 30: the modified method of Graves et al. further discloses the invention including providing the user with an opportunity to select the amount of the wager and the wager type (as taught by both Graves et al. and Brenner et al., see Supra); and

- As for Claim 31: the modified method of Graves et al. further discloses the invention including providing the user with an opportunity to select multiple horses using the wagering application; and automatically placing a wagers for each horse when it is determined that the horse is to run in a particular race (see Supra Claim 16 for the Graves et al.'s multiple wagering and Brenner et al. for selecting the particular horse in the particular race).

As for Claim 32:

Graves et al. discloses an interactive wagering system, comprising:

user equipment configured to:

select desired wagering criteria (col. 4, lines 17-42; col. 4, line 55 – col. 5, line 21; col. 6, line 58 - col. 7, line 4; see Fig. 1);

determine whether a desired wagering opportunity exists; and

automatically take a particular action (automatically placing a wager) whenever the wagering criteria are satisfied (see Supra and Figs. 1-4).

However, Graves et al. does not expressly disclose the invention that allows the user to select a given horse and place a wager for the horse in a particular race.

Brenner et al. teaches, for a interactive wagering system for horse racing games, that the system allows the user to select a particular racetrack, a particular horse; to search for a desired horse with a remote control; to select a particular jockey, a particular trainer, a particular track surface, a particular race distance, a particular racing statistics, and a particular silk color; and to wager by odds for a horse change from that horse's morning line odds (see Figs. 3, , 5, 8-28, 36-50 and the descriptions thereof).

Since Brenner et al. and Graves et al. are both from the same field of endeavor, the purpose disclosed by Brenner et al. would have been well recognized in the pertinent field of Graves et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the system of Graves et al. to play the horse racetrack wagering (to select a particular racetrack, a particular...), as taught by Brenner et al., for the purpose of providing the user with the interactive wagering systems and related processes for off-track horse racing wagering in which a user terminal provides racing odds, pools, handicapping information, and other racing data.

- As for Claim 33: the modified system of Graves et al. further discloses the system including user computer equipment separate from the user television equipment, wherein the wagering application notifies the user at the user computer equipment by e-mail (see Supra pertinent Claims).

As for Claims 52, 54-58:

The modified medium of Graves et al. further discloses the invention including:  
notifying the user by displaying a partial-screen overlay message on top of a screen (col. 2, lines 43-46 of Brenner et al.) – Claim 52;  
notifying the user via a wireless message (col. 7, lines 35-38 of Brenner et al.) – Claim 54;  
notifying the user that the wagering criteria have been satisfied by displaying a message on the TV (col. 1, lines 13-15 of Brenner et al.) – Claim 55;  
providing a display screen containing a summary of which types of wagering criteria have been established (col. 3, lines 15-18 of Brenner et al.) – Claim 56;  
wherein the summary includes information on wager amounts and wager types that the user has established for use whenever various sets of wagering criteria are satisfied (col. 2, lines 47-53 of Brenner et al.) – Claim 57; and  
wherein the summary includes information on wager amounts and wager types that the user has established for use whenever various sets of wagering criteria are satisfied (col. 2, lines 47-53 of Brenner et al.) – Claim 58.

10) Claims 28 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graves et al. as applied to Claims 1 and 34 above, and further in view of Hedges et al. (US 4,467,424).

Graves et al. discloses the invention as cited earlier, but does not specifically disclose the invention comprising:

using the wagering application to provide the user with an opportunity to select an expiration time for automatic wagering.

Hedges et al. is cited to show that there is an expiration time to enter a bet.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Graves et al. such that the user can select an expiration time for automatic wagering, as taught by Hedges et al., for the purpose of reminding the user of the remaining time and providing the user with the opportunity to change or cancel the wagering.

### ***Conclusion***

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (571)272-6708. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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John Hayes  
Supervisory Patent Examiner  
GAU 3628  
July 31, 2007